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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,243	03/14/2001	Richard Muhlbacher	LEAR 0835 PUS	4800

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EXAMINER
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THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/808,243

Applicant(s)

MUHLBACHER ET AL.

Examiner

Camie S Thompson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed January 7, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's amendment and accompanying remarks filed January 7, 2004 have been acknowledged.
2. The rejection of claims 1-4, 6-7, 15, 18-19 and 22-25 under 35 U.S.C. 102(b) as being anticipated by Haeseker et al., U.S. Patent Number 4,479,992 is withdrawn due to applicant's argument.
3. The rejection of claims 1, 5, 13 and 20 under 35 U.S.C. 103(a) as being unpatentable over Haeseker et al., U.S. Patent Number 4,479,992 is withdrawn due to applicant's argument.
4. The rejection of claims 1, 11, 12, 17 and 21 under 35 U.S.C. 103(a) as being unpatentable over Haeseker et al., U.S. Patent Number 4,479,992 in view of Caudill et al., U.S. Patent 4,541,885 is withdrawn due to applicant's argument.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 17 and 21 recites the limitation "the connection layers" in the second line. There is insufficient antecedent basis for this limitation in the claim. There are no connection layers in claim 1, from which claim 17 depends.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 6-7, 10-12, 14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Caudill, Jr., U.S. Patent Number 4,541,885.

Caudill teaches an interior component for an automobile that comprises a cover layer that is applied over a two-layer foam laminate as per instant claim 1 (see column 2, lines 30-41). The reference also discloses that component comprises an intermediate layer that is a thin, flexible polyurethane foam as per instant claims 10 and 14 (see column 1, lines 35-40 and column 2, lines 35-40). Additionally, the reference discloses upper and lower foam (polyurethane) panels as per instant claims 1 and 11-12 (see Figure 2 and column 2, lines 18-29). It is also disclosed in the reference that the cover layer is a decorative layer as per instant claim 1 (see column 2, lines 30-40). Figure 2 of the reference discloses that the upper and lower foam panels are interconnected along their whole area of contact and that the upper foam panel has a smaller lateral dimension than the lower foam panel as per instant claims 2 and 6. Also, figure 2 of the reference discloses that the upper and lower foam panels have different material thicknesses as per instant claim 3. Claims 1, 7 and 18 are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a

Art Unit: 1774

product of the prior art, the claim is unpatentable even though the prior art was made by a different process. The manner in which the foam panels bonded together does not make the component of the Caudill reference different from applicant's component. Both Caudill and applicant have upper and lower foam panels that are bonded together. The Caudill component is the same as applicant's. The limitation "for a vehicle roof" goes to intended use and is given little patentable weight in a product claim. In response to applicant's argument that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 5, 13 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caudill, Jr., U.S. Patent Number 4,541,885.

Art Unit: 1774

Caudill teaches an interior component for an automobile that comprises a cover layer that is applied over a two-layer foam laminate as per instant claim 1 (see column 2, lines 30-41).

Additionally, the reference discloses upper and lower foam (polyurethane) panels as per instant claim 1 (see Figure 2 and column 2, lines 18-29). It is also disclosed in the reference that the cover layer is a decorative layer as per instant claim 1 (see column 2, lines 30-40). Figure 2 of the reference discloses that the upper and lower foam panels are interconnected along their whole area of contact and that the upper foam panel has a smaller lateral dimension than the lower foam panel. Also, figure 2 of the reference discloses that the upper and lower foam panels have different material thicknesses. Therefore, it would have been obvious to one of ordinary skill in the art that each foam panel have different porosities as the upper and lower foam panels have different material thicknesses. Caudill does not disclose that the support layer has a greater flexural strength than the decorative and intermediate layers as per instant claim 19. However, this is an optimizable feature. The flexural strength of the support layer comprising the upper and lower foam panels affects the stiffness and rigidity of the component. Discovery of optimum values of a result effective variable involves only routine skill in the art in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to one of ordinary skill in the art to have the ratio of the material thickness for the upper and lower foam layers at 0.01 to 0.95 in order to have a support layer that provides for greater compressive strength and rigidity. Claim 1 is a product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the

Art Unit: 1774

claim is unpatentable even though the prior art was made by a different process. The manner in which the foam panels bonded together does not make the component of the Caudill reference different from applicant's component. Both Caudill and applicant have upper and lower foam panels that are bonded together. The Caudill component is the same as applicant's. The limitation "for a vehicle roof" goes to intended use and is given little patentable weight in a product claim. In response to applicant's argument that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

11. Claims 1, 8, 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caudill, Jr., U.S. Patent Number 4,541,885 in view of Ohta et al., U.S. Patent Number 4,791,019. Caudill teaches an interior component for an automobile that comprises a cover layer that is applied over a two-layer foam laminate as per instant claim 1 (see column 2, lines 30-41). Additionally, the reference discloses upper and lower foam (polyurethane) panels as per instant claim 1 (see Figure 2 and column 2, lines 18-29). It is also disclosed in the reference that the cover layer is a decorative layer as per instant claim 1 (see column 2, lines 30-40). Figure 2 of the reference discloses that the upper and lower foam panels are interconnected along their whole area of contact and that the upper foam panel has a smaller lateral dimension than the lower foam panel. Caudill does not disclose an reinforcing mat arranged on the back of the upper foam panel

Art Unit: 1774

facing away from the lower foam panel as per instant claim 8. Ohta teaches a polyurethane foam interior finishing material used in the interior of motor vehicles wherein the foam has an expanded pad layer with a continuous glass strand mat with reinforced glass fibers primarily to the rear side of the polyurethane foam material as per instant claims 8 and 16 (see Ohta abstract). Therefore, it would have been obvious to one of ordinary skill in the art to have a continuous strand mat with glass fibers on the back of the polyurethane foam because the mat would provide a soft feel and excellent rigidity and strength for better reinforcement (see Ohta: column 2, lines 41-51). Claim 1 is a product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. The manner in which the foam panels bonded together does not make the component of the Caudill reference different from applicant's component. Both Caudill and applicant have upper and lower foam panels that are bonded together. The Caudill component is the same as applicant's. The limitation "for a vehicle roof" goes to intended use and is given little patentable weight in a product claim. In response to applicant's argument that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the



Art Unit: 1774

prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

12. Claims 1, 8-9, 15 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caudill, Jr., U.S. Patent Number 4,541,885 in view of Ohta et al., U.S. Patent Number 4,791,019 and in further view of Haeseker et al., U.S. Patent Number 4,479,992.

Caudill teaches an interior component for an automobile that comprises a cover layer that is applied over a two-layer foam laminate as per instant claim 1 (see column 2, lines 30-41).

Additionally, the reference discloses upper and lower foam (polyurethane) panels as per instant claim 1 (see Figure 2 and column 2, lines 18-29). It is also disclosed in the reference that the cover layer is a decorative layer as per instant claim 1 (see column 2, lines 30-40). Figure 2 of the reference discloses that the upper and lower foam panels are interconnected along their whole area of contact and that the upper foam panel has a smaller lateral dimension than the lower foam panel. Caudill does not disclose an reinforcing mat arranged on the back of the upper foam panel facing away from the lower foam panel as per instant claim 8. Ohta teaches a polyurethane foam interior finishing material used in the interior of motor vehicles wherein the foam has an expanded pad layer with a continuous glass strand mat with reinforced glass fibers primarily to the read side of the polyurethane foam material as per instant claims 8 and 16 (see Ohta abstract). Therefore, it would have been obvious to one of ordinary skill in the art to have a continuous strand mat with glass fibers on the back of the polyurethane foam because the mat would provide a soft feel and excellent rigidity and strength for better reinforcement (see Ohta: column 2, lines 41-51). Neither Caudill nor Ohta teach the use of a cover fleece arranged on the reinforcing mat as per instant claims 9 and 15. Haeseker teaches a sound absorbing structural element that

Art Unit: 1774

comprises a decorative layer, an intermediate layer and a support layer (see column 2, lines 20-65). Additionally, Haeseker teaches that the structural element can be used as a roof soffit for automobiles. Also, Haeseker discloses that the support layer has a polyester fiber fleece facing away from the foam panels as per instant claims 9 and 15 (see column 2, lines 24-29 and column 4, lines 5-6). Claim 1 is a product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. The manner in which the foam panels bonded together does not make the component of the Caudill reference different from applicant's component. Both Caudill and applicant have upper and lower foam panels that are bonded together. The Caudill component is the same as applicant's. The limitation "for a vehicle roof" goes to intended use and is given little patentable weight in a product claim. In response to applicant's argument that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Art Unit: 1774

13. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

14. Applicant's arguments with respect to claims 1-22 and 24-25 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (571) 272-1530. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (571) 272-1526. The fax phone number for the Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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